

REMARKS

The last Office Action of January 8, 2007 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-21 are pending in the application. Claims 1-8 have been withdrawn from further consideration. No amendment to the claims and specification has been made. No fee is due.

Claims 9-11, 14-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 01/63605 A1 to Eichlseder in view of U.S. Pat. No. 5,612,068 to Kempf (hereinafter Kempf '068).

Claims 12-13, 16-19, 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Eichlseder and Kempf '068, and further in view of U.S. Pat. No. 6,054,029 to Kempf (hereinafter Kempf '029).

In general, applicant wishes to note that the Examiner's rejection is confusing and allows applicants only to speculate as to the portions of each reference relied upon. In rejecting independent claim 9, the Examiner merely repeated the wording of claim 9, without any reference to any portions in Eichlseder. The Examiner clearly failed to comply with the practice set forth in §706.02(j) of the Manual of Patent Examining Procedure which contains a discussion of what an Examiner should set forth in an Office Action under 35 U.S.C. §103(a). Accordingly, the Examiner is requested to indicate to applicant which specific portions (page and line or figure) of the Eichlseder reference the Examiner refers to base his rejection on. *Ex parte Gambogi*, 62 USPQ2d, 1209 (Board of Patent Appeals and Interferences), *Ex parte Jones*, 62 USPQ2d, 1206 (Board of Patent Appeals and Interferences).

Applicant also respectfully disagrees with the Examiner's rejection of claim 9 for the following reasons:

Claim 9 on file is directed to an apparatus for making bonded discs of two substrates, with the apparatus having a plurality of processing stations that are

arranged about a circle. More specifically, the processing stations include a transfer station, a joining station, a quality inspection station, and first and second delivery stations. In contrast thereto, in Eichlseder, corresponding processing stations are not arranged about a circle. The Examiner's attention is drawn to Fig. 3 of Eichlseder and in particular to the inspection station (scanner 24) and the first delivery station (29) for acceptable discs. These processing stations are not arranged about a circle. Moreover, Eichlseder fails to disclose the provision of a second delivery station for unacceptable discs.

In addition, as the Examiner acknowledged, Eichlseder fails to disclose the particular configuration of the central handling system, as set forth in claim 9. To bridge the absence of teaching, the Examiner applied Kempf '068. Claim 9 sets forth the provision of a gripper arm that has two gripper elements arranged behind one another so as to enable the gripper elements to sweep over two concentric circles of different diameter. To present a case of obviousness, the Examiner notes that Kempf '068 discloses "*a first type of gripper arms (which) has two gripper elements (see, for example, items 18' and 29).*" Applicant respectfully disagrees with the Examiner's notion that a combination of Eichlseder and Kempf '068 produces the present invention.

Gripper arms 18' and 29 have a T-shaped configuration, allowing two substrates to be held side-by-side. The same is true also for the Eichlseder reference which shows a tandem gripper (19) to hold two substrates side-by-side. Thus, none of these prior art gripper arms have a configuration with two gripper elements disposed behind one another. While recognizing the absence of teaching of this feature, the Examiner merely notes that this constitutes "*an obvious rearrangement*". This assessment by the Examiner is ill-advised. Apart from the fact, that a modification of either Eichlseder and Kempf '068 with a gripper arm, as set forth in claim 9, would render these installations inoperative, it is applicant's contention that this rejection is also improper in the context of the present invention and requests a citation or an Examiner's affidavit that provides such citations. As stated by the Federal Circuit in *In re Lee*, 61 USPQ2d, 1434, 1435,

"Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.". The Court also stated that "The Board's findings must be documented on the record,".

The particular configuration of the central handling system, as set forth in claim 9, constitutes an essential feature of the present invention to provide an effective and reliable apparatus, and it is applicant's contention that the Examiner's omission of a relevant factor required by precedent is both legal error and arbitrary agency action. See *Motor Vehicle Manufacturers*, 463 U.S. at 43. (compare *In re Lee* 61 USPQ2d).

For the reasons set forth above, it is applicant's contention that neither Eichlseder nor Kempf '068, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 9.

As for the rejection of dependent claims 10-21, these claims depend ultimately on claim 9, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific discussion thereof is necessary.

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully

requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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